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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,415	12/30/1999	DALE SANDBERG	3855.29	7821

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EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/476,415

Applicant(s)

SANDBERG, DALE

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-29, 31-38, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-29, 31-38, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 7 April 2004 has been entered.

2. This communication is in response to the RCE filed 7 April 2004. Claims 21-29, 31-38, and 40-41 are pending. Claims 21 and 33 have been amended.

### ***Specification***

3. The amendment filed 13 June 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention.

The added material which is not supported by the original disclosure is as follows:

The newly added recitation to wherein the step for generating the customizable form comprises: selectively defining display specifications that relate to at least one of :

i) a display of the healthcare procedures characteristically performed by the particular healthcare provider and

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(ii) a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preference.

within claims 21 and 33 appears to constitute new matter. In particular, Applicant does not point to, nor was the Examiner able to find any support for these new limitations within the specification as originally filed. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

4. Claims 21 and 33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention and for the reasons set forth in the objection to the specification above.

Independent claims 21 and 33 recite limitations that are new matter, as discussed above.

Claims 22-29, 31-32, 34-38, and 40-41 are dependent on claims 21 and 33, and incorporate the deficiencies of independent claims 21 and 33, through dependency, and are also rejected.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**NOTE:** The following rejections assume that the subject matter added in 7 April 2004 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in preceding sections above in the next communication sent in response to the present Office Action.

6. Claims 21-29, 31-38, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (5,924,074) in view of Feldon et al. (5,732,221) and Lavin et al. (5,772,585).

(A) As per claims 21- 22, 24-25, and 31-32, Evans discloses a medical records method and system for storage and retrieval of dynamic electronic medical records in a computer environment, such as a local or wide area network including portable computers (col. 1 lines 5-10), wherein patient data, such as patient complaints, lab orders, medications, diagnoses, and procedures, are captured at the point of care of a patient in real-time, such as during an

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examination or in hospital (see Figure 24), using a graphical user interface having touch screens in a point of care system (Abstract; lines 1-5; col. 2 lines 20-64, col. 5 lines 29-55, and col. 5 lines 8-10), comprising:

(a) selecting a procedure from a list of procedures administered by a physician of a healthcare facility, wherein the procedures reflect treatments of a physician, and wherein the procedures are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(b) selecting a diagnosis from a list of diagnoses made by a physician of a healthcare facility, wherein the diagnosis indicates the proper administration of procedures to be performed by a physician, and wherein the diagnoses are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(c) activating the form for use by a health care provider when diagnosing and performing a procedure or administering a treatment on a patient (Figures 1,5-6, 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64); and

(d) using the form to select a procedure, wherein the procedures reflect treatments of a physician, and wherein the procedures are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64) and to select a diagnosis from a list of diagnoses made by a physician of a healthcare facility, wherein the diagnosis indicates the proper administration of procedures to be performed by a physician, and wherein the diagnoses are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64).

Evans fails to expressly recite a "customizable form".

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Feldon discloses entering a patient's demographic information, medical history, prescribed medication and other relevant information for a patient, including information a physician documents during the exam using exam descriptors, into data entry forms, wherein a user is able to customize these data entry forms by editing existing forms or by redesigning completely new forms, wherein the form is able to be saved using a computer (Figure 1, col. 4 lines 13-63, col. 8 lines 62-67, and col. 9 lines 15-65, col. 11 lines 1-58, and col. 12 lines 1-9).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the aforementioned features of Feldon within the method of Evans with the motivation of allowing forms to be generated based on the user's needs and customized for the particular task at hand (Feldon; col. 4 lines 52-54) and transforming a patient chart from a static record of a few clinical interactions into a dynamic, real-time comprehensive record (Evans; col. 2 lines 34-40).

Evans and Feldon fail to expressly disclose patients wherein the step for generating the customizable form comprises: selectively defining display specifications that relate to at least one of :

- i) a display of the healthcare procedures characteristically performed by the particular healthcare provider and
- (ii) a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preference.

Lavin discloses creating a customized list for a health care provider's practice specialty, wherein the customized list relates to diagnoses and procedures used in the specialty (reads on "a display of the healthcare procedures characteristically performed by the particular healthcare provider" and "a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preference") (Figure 13, col. 9 lines 29-40). Further, Lavin discloses creating and viewing the customized list in a graphical user interface (reads on "customizable form") (Fig. 17, col. 3 line 65 to col. 4 line 17, col. 13 lines 28-59).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Lavin within the method taught collectively by Evans and Feldon with the motivation of maximizing the efficiency and effective use of the physician's time (col. 15 lines 46-59) by providing customized lists created for a particular physician's practice specialty (Fig. 13).

(B) As per claim 23, Evans discloses a data interface permitting communication with external sources to obtain patient data and to transfer patient information to external health care providers, such as demographic data, laboratory test results, x-ray images, ICD9 diagnosis codes and CPT procedure codes, prescriptions for medications (col. 9 lines 1-14). The remainder of claim 23 repeats the same limitations as claim 21, and is therefore rejected for the same reasons given for



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claim 21, and incorporated herein. It is noted that the step of transferring patient information, including ICD9 diagnosis codes and CPT procedure codes, to external health care providers (col. 9 lines 1-14) is considered to be a form of "one or more other healthcare procedures or diagnoses used by another healthcare provider of a healthcare facility" as recited in claim 23.

(C) As per claim 26, Feldon discloses customizing data entry forms for a physician, for example for an examination of the eye by defining common types of eye exams (col. 1 line 20 to col. 2 line 12 and col. 4 lines 30-45). The remainder of claim 26 repeats the same limitations as claim 21, and is therefore rejected for the same reasons given for claim 21, and incorporated herein. The motivation for combining Feldon within Evans is given above in claim 21, and is incorporated herein.

(D) As per claim 27-29, Evans discloses entering and updating a patient record using a form, wherein the patient record includes insurance information, ICD9 diagnosis codes and CPT procedure codes, wherein upon entering and updating information, the electronic medical record system filed the patient's record in real-time in the patient data repository (Abstract, lines 1-2; Fig. 2-3, 5-6, and 14, col. 5 lines 1-27, col. 6 line 55 to col. 7 line 5, col. 9 lines 1-14).

It is noted that Evan's discloses recording insurance information as well as diagnosis and procedure codes within a patient record as discussed above (Abstract, lines 1-2; Fig. 2-3, 5-6, and 14, col. 5 lines 1-27, col. 6 line 55 to col. 7

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line 5, col. 9 lines 1-14). As this information is most frequently used for billing purposes (i.e., billing insurance companies), it is respectfully submitted that this information within the patient record is a form of a "billing record." Furthermore, as per the recitation of "the billing record corresponding to standards in the industry," it is noted that ICD9 codes and CPT codes are widely accepted codes used to report and index medical records and are considered to be the standard codes set for reporting health care services in electronic data transactions.

(E) Claims 33-38 and 40-41 differ from method claims 21-29 and 31-32 by reciting hardware elements, namely, a computer readable medium and computer program code which is executable. As per these elements, Evans discloses:

(a) a multi-processor personal computer having 20 GB of storage capacity (col. 12 line 66 to col. 13 line 30); and

(b) applications running under Microsoft ® Windows ™ to access data from a variety of data sources (col. 13 line 57 to col. 14 line 25).

The remainder of claims 33-38 and 40-41 repeat the same limitations as claims 21-29 and 31-32, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 21-29, 31-38, and 40-41 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

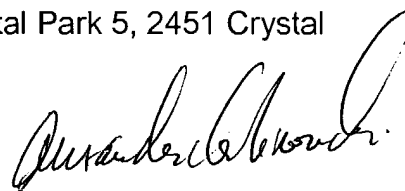
(703) 746-8374 [Informal/ Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).



CB

July 1, 2004



**ALEXANDER KALINOWSKI  
PRIMARY EXAMINER**